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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/284,530
Filing Date	April 14, 1999
First Named Inventor	Markus PLACHO
Art Unit	2681
Examiner Name	E. A. Gary
Total Number of Pages in This Submission	
Attorney Docket Number	449122016200

ENCLOSURES (*Check all that apply*)

- [x] Fee Transmittal Form
- [ ] Fee Attached
- [ ] Amendment/Reply
- [ ] After Final
- [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
- [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) (please Identify below):

Return Receipt Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Kevin R. Spivak		
Date	December 27, 2004	Reg. No.	43,148

I hereby certify that this correspondence is being hand carried to the U.S. Patent and Trademark Office in Alexandria, Virginia, on the date shown below.

Dated: December 27, 2004 Signature: _____ (Kevin R. Spivak)

va-88813

PTO/SB/17 (12-04)
Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	09/284,530
Filing Date	April 14, 1999
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Art Unit	2681
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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 03-1952 Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or any underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
Application Type	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fees Paid ($)**
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	**Fee ($)**	**Small Entity Fee ($)**
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims		**Extra Claims**		**Fee ($)**		**Fee Paid ($)**
_____	- =	_____	x	_____	=	_____

Multiple Dependent Claims

Fee ($)	**Fee Paid ($)**
_____	_____

Indep. Claims		**Extra Claims**		**Fee ($)**		**Fee Paid ($)**
_____	- =	_____	x	_____	=	_____

3. APPLICATION SIZE FEE

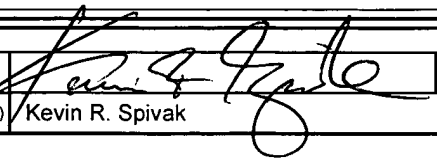
If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets		**Extra Sheets**		**Number of each additional 50 or fraction thereof**		**Fee ($)**		**Fee Paid ($)**
_____	- 100 =	_____	/50	_____	(round up to a whole number) x	_____	=	_____

4. OTHER FEE(S)

	Fees Paid ($)
1402 Filing of Brief in Support of Appeal	500.00
Other: _____	_____

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	43,148	Telephone	(703) 760-7762
Name (Print/Type)	Kevin R. Spivak			Date	December 27, 2004

va-88607

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the application of:

Markus PLACHO et al.

Serial No.: 09/284,530

Filing Date: April 14, 1999

For: PHOTOSENSITIVE RESIN LAMINATE FOR SIGN BOARDS

Examiner: Erika A. Gary

Prior Group Art Unit: 2681

APPELLANTS' BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a timely appeal from the final rejection of claims 1-19, in the Office Action mailed April 28, 2004.

I. REAL PARTY IN INTEREST

The real party in interest is Siemens Aktiengesellschaft.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR 1.192(c)(2) known to Appellants or their undersigned counsel.

III. STATUS OF CLAIMS

Claims 1-19 (reproduced in the attached Appendix) are pending in this application.

Claims 1-19 are finally rejected under 35 USC 103(a), as being obvious over U.S. Pastent No. 5,396,543 (Beeson) in view of Bjorndahl.

IV. STATUS OF AMENDMENTS

Appellants filed proposed after-final Amendments to claims 1 and 19 on August 30, 2004, but the amendments were not entered.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention is directed at overcoming the problem which arises when a network provider needs a network manufacturer to implement a complicated modification of switching actions in a switching system, for example, for flexibly routing various call connections for individual/selected subscribers. To solve this problem, the invention, as characterized by independent claims 1 and 19, provides a method and an apparatus in which the data which defines conditions for specific subscriber-controlled switching actions is established in the mobile switching center, and it is established on a subscriber-by-subscriber basis (i.e., "subscriber-individually") by the operation and maintenance system. In addition, once the conditions for subscriber-specific switching control data is established in the mobile switching center, the mobile switching center evaluates data from incoming calls, outgoing calls, etc., against the data defining the established conditions to determine if certain subscriber-set conditions are met. If one or more conditions are met, the mobile switching center carries out the corresponding subscriber-dependent switching action.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-19 stand rejected under 35 USC 103(a) as obvious over U.S. Patent No. 5,396,543, in view of Bjorndahl, P. "CME 20- A Total Solution for GSM Networks."

VII. ARGUMENT

A. The rejection of claims 1-19 under 35 USC 103(a) should be reversed.

Claims 1-19 stand rejected under 35 USC 103(a) as being unpatentable over Beeson, Jr., et al., U.S. Patent No. 5,396,543, in view of Bjorndahl, P. "CME 20- A Total Solution for GSM Networks". Because neither Beeson nor Bjorndahl disclose certain express claim limitations, reversal of the examiner's rejection of claims 1-19 is proper and appropriate.

Independent claims 1 and 19 both require establishing telephone-specific data for defining conditions for subscriber control of certain actions, wherein this data is established in a mobile switching center "subscriber-individually" via an operation and maintenance sub-system.

Independent claims 1 and 19 both further require that the mobile switching center evaluate call-related data or subscriber data against the "conditions" and, providing that a "condition" is satisfied, the mobile switching center control an action in a subscriber-dependent fashion (i.e., according to a subscriber-programmed instruction).

Admitting that Beeson fails to disclose the first of these limitations, the examiner asserts that it is disclosed by Bjorndahl, citing Bjorndahl at page 78, column 2, last paragraph – page 79, col. 1, first paragraph, and Figures 5 and 6. However, careful review of Bjorndahl reveals that it discloses none of the claim limitations that are missing from the Beeson reference.

According to page 78, col. 2, last paragraph of Bjorndahl, "all subscription parameters are stored in the home location register (HLR)." In other words, subscription parameters are not established in the mobile switching center as required by the claims, but in the home location register. The distinction between a home location register and a mobile switching network is well known to persons of ordinary skill in the art, as evidenced by their respective definitions in Newton's Telecom Dictionary. In short, an HLR is a database for subscriber data and not a mobile switching center (MSC), which is a center for switching. Therefore, given that an HLR and an MSC are accorded different meanings by persons of skill in the art, the disclosure of Bjorndahl cannot be said to correspond to the recitation of claims 1 and 19.

In addition to the foregoing, Bjorndahl does not disclose establishing data on a subscriber-by-subscriber basis or "subscriber-individually" as required by the claims. Instead, Bjorndahl specifically discloses the performance of a "complete upload" for installing an HLR. Moreover, the subscription parameters disclosed in Bjorndahl do not define conditions for a subscriber-contended control of actions "in" a mobile switching center as required by claims 1 and 19.

With respect to the requirement of claims 1 and 19 that the mobile switching center evaluate call-related or subscriber-related data against the "conditions" and, given a satified condition, carry out an action in a subscriber-dependent fashion, neither Beeson nor Bjorndahl contain any disclosure corresponding to this limitation. Beeson merely discloses subscriber control of an action, such as modifying call forwarding, via the HLR. As the use of an HLR for subscriber control of actions in a mobile switching center is completely different from establishing definitions of conditions via an operation and maintenance sub-system (i.e., not via the subscriber or via the HLR), persons of ordinary skill in the art would not read Beeson to meet this requirement of claims 1 and 19.

In addition to the foregoing, Appellants respectfully submit that there is no suggestion in the prior art that would have motivated persons of ordinary skill in the art to combine the teachings of Beeson and Bjorndahl as suggested by the exmainer. First, Beeson is directed to the technical field of "signaling arrangements," and Bjorndahl is directed to international roaming services in an Ericsson GSM system. While in some very broad sense they may be related technologies, the specifics of what is disclosed in the respective references is sufficiently distinct such that one of ordinary skill in the art would not have been motivated to consider Bjorndahl to modify Beeson to "perform tasks in the operation and maintenance sub-system to reduce administrative work load and enable management of rapid growth," as asserted by the examiner.

Moreover, even if Beeson with Bjorndahl were combined, such a combination would not result in an operable device because, according to Bjorndahl, "all subscription parameters are

stored in the home location register (HLR) . . and the parameters are entered by use of OSS." That is, according to Bjorjdahl, as discussed above, a complete upload is performed for installing a HLR, and, according to Beeson, data changes are "customer initiated" (page 12, line 2), so that if the data in both applications were the same, "specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually" (claim 1) – which they are not in both cases - the combination could not work as data cannot be changed individually customer defined and at the same time also be installed generally (not subscriber-individually) by an HLR upload. Accordingly, combination of disparate teachings from these two references in disparate fields would not have resulted in the inventions set forth in claims 1 and 19.

Claims 2-18, depend either directly or indirectly from claim 1, are similarly patentable. In view of the foregoing, Appellants respectfully request that this rejection be withdrawn.

CONCLUSION

For the foregoing reasons, Appellants respectfully request that the rejection of claims1-19 under 35 USC 103(a) be reversed. All claims are, therefore, believed to be in condition for allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 449122016200.

Respectfully submitted,

Dated: December 27, 2004

By: _____
Kevin Spivak.
Registration No. 43,148

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APPENDIX OF APPEALED CLAIMS

1. A method for controlling switching-oriented actions in a mobile radio telephone system having at least one radio-oriented sub-system with base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers, having a switching-oriented sub-system with subscriber data bases and mobile switching centers for line-switched connections and having an operation and maintenance sub-system. the operation and maintenance sub-system having at least one operation and maintenance center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system, comprising the steps of:

establishing respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually for at least one mobile subscriber via the operation and maintenance sub-system; and

respectively evaluating in the mobile switching center, given one of an incoming calls an outgoing call or a message transmission at least one of call-related data and subscriber specific data with respect to the conditions and, given a satisfied condition, controlling at least one action subscriber-dependent.

2. The method according to claim 1, wherein the conditions for the subscriber-dependent control of the actions are respectively defined by one of a single, call-related/subscriber-specific datum and an operation of a plurality of call-related/subscriber-specific data.

3. The method according to claim 2, wherein operation of the call-related/subscriberspecific data ensues via at least one of a logical AND operation and a logical OR operation.

4. The method according to claim 1, wherein, given a plurality of satisfied conditions, different actions are controlled subscriber-dependent.

5. The method according to claim 1, wherein, given the parallel existence of a plurality of

satisfied conditions, the actions are provided with priority numbers with which is defined a sequence of the actions to be controlled.

6. The method according to claim 4, wherein, given parallel existence of a plurality of satisfied conditions, blocking information is used to exclude a respective action of said actions from the control by another action of said actions.

7. The method according to claim 6, wherein the blocking information is entered into a table that is located in one of the mobile switching center and a subscriber data base of the mobile switching center.

8. The method according to claim 1, wherein one of a type of call or type of message transmission is evaluated as call-related data.

9. The method according to claim 1, wherein one of an international mobile subscriber identifier, a service class mark for triggering services of an intelligent network, a mobile subscriber category or supplementary services usable by the mobile subscriber is evaluated as subscriber-specific data.

10. The method according to claim 1, wherein given an outgoing call, a subscriber telephone number selected by the mobile subscriber or a numerical range of the selected subscriber telephone number is evaluated and, wherein the location telephone number or a numerical range of the location telephone number assigned in the mobile radio telephone system, respectively, is evaluated given the incoming call.

11. The method according to claim 1, wherein, given an incoming call with call forwarding to a destination telephone number, the destination telephone number or a numerical range of the destination telephone number is evaluated.

12. The method according to claim 1, wherein one of blocking of a call, suppression of a call forwarding, and blocking of message transmission is controlled subscriber-dependent as an

action.

13. The method according to claim 1, wherein one of cleardown of a call and routing of a call to an announcement device are controlled subscriber-dependent as actions.

14. The method according to claim 1, wherein one of routing of a call connection to a specific destination and acquisition of call charges in a specific charge zone are controlled subscriber-dependent as actions.

15. The method according to claim 1, wherein routing of a call connection to a service control point of an intelligent network is controlled subscriber-dependent as an action, and a service class mark is thereby set preceding a destination telephone number.

16. The method according to claim 1, wherein a telephone number modification by insertion of subscriber-individual information into one of a selected telephone number given an outgoing call, a location telephone number given an incoming call or a destination telephone number given an incoming call with call forwarding is controlled subscriber-dependent as an action.

17. The method according to claim 1, wherein an eavesdropping of a call connection or an authorization or, respectively, suppression of services/performance features are controlled subscriber-dependent as actions.

18. The method according to claim 1, wherein a conversion of an abbreviated code selected by the subscriber into a telephone number is controlled subscriber-dependent as an action.

19. A mobile radio telephone system for controlling switching-oriented actions, comprising:

at least one radio-oriented sub-system that has base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers;

a switching-oriented sub-system that has subscriber data bases and mobile switching centers for line-switched connections,

an operation and maintenance sub-system having at least one operation and maintenance

center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system;

mobile radio telephone-specific data for defining conditions for a subscriber-dependent control of the actions, the mobile radio telephone specific data being subscriber-individually established for at least one mobile subscriber in the mobile switching center via the operation and maintenance sub-system , and the mobile switching center having a device that, given an incoming call or an outgoing call or given a message transmission, respectively evaluates at least one of call-related data and subscriber-specific data with reference to the conditions and, given a satisfied condition, controls at least one action subscriber-dependent.